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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,718	07/23/2003	David Ryan Breese	88-2042A	8126
33967	7590	10/14/2005	EXAMINER	
EQUISTAR CHEMICALS, L.P. 11530 NORTHLAKE CINCINNATI, OH 45249			ZEMEL, IRINA SOPJA	
			ART UNIT	PAPER NUMBER
			1711	

DATE MAILED: 10/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/625,718

Applicant(s)

BREESE ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction of amended claims 1-5 from originally presented claims 1-12 as non-elected by the original presentation is withdrawn in view of the applicants statement on the record that the patentability of the claims as amended do not depend on the preamble recitation, i.e., "[a]pplicants use of the term extrusion coating in the preamble of currently amended Claims 1-5 is not a limitation since what follows is a self-contained description of the claimed subject matter. The claims do not depend on the preamble for completeness and the term extrusion coating merely recites a property and contemplated use." See page 5 of the 8-2-2005 response.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 4,247,584 to Widiger et al., (hereinafter "Widiger").

The rejection of claims 1-5 stands as per reasons of redord, As discussed in the previous office action, the reference discloses that preferred blend exhibit lower melt index (MI) than the MI claimed in claim 1. However, MI corresponding to the claimed MI are within the purview of the reference based on individual MI of the components and their respective amount. Furthermore, it is well known in the art that the mechanical and processability characteristics of the polymer and polymer blend depend on the MI of the polymers and varying MI with expectation to vary

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corresponding mechanical properties of the polymer is well within the skills of ordinary artisan absent shoeing of unexpected results that can be clearly attributed to the claimed MI. The preamble limitation of extrusion coating (intended use) is given weight only to the extent that the composition disclosed in the reference is capable of being used such. The disclosed composition is inherently capable for the claimed use because the claimed composition is believed to be identical to the composition disclosed in the reference. Therefore, the preamble limitation is anticipated by the reference. Furthermore, as admitted by the applicants, the term extrusion coating in the preamble of currently amended Claims 1-5 is **not** a limitation since what follows is a self-contained description of the claimed subject matter. As admitted by the applicants, the claims do **not** depend on the preamble for completeness, thus, the preamble recitation does not contribute to the patentability of the claimed composition.

### ***Response to Arguments***

Applicant's arguments filed 8-2-2005 have been fully considered but they are not persuasive. The applicants argue that the reference teaches away from using blends with high melt indices (MIs) by suggesting that poor results would be obtained from such compositions. While the reference discusses that less beneficial results may be obtained with the composition having higher MIs, the examiner is still of the opinion that the reference discloses compositions falling within the claimed MI range and also claim such compositions. The applicants argue that the MI of the blend disclosed in the reference must be in the range of not less than 0.6 (as specified in column 3, line 32).

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The examiner can not agree with this position. While the range specified in column 3, line 32, may be the preferred range, it is clear from the disclosure of the reference, that the broad ranges disclosed and claimed in the reference encompass compositions with significantly higher MI. For example, even if the lowest amount of polymer with MI=10 is used, the MI of the resulting composition is still significantly higher than the highest limit of the preferred range (regardless of what MI of the second component is). The examiner has NO reasons to believe that the expressed disclosure of the reference and the composition as claimed, for example in claim 7 of a valid US patent is, somehow, contradictory to the teachings of the same reference. Furthermore, it is immaterial whether the preferred embodiments have different properties as long as the reference provides the disclosure of the compositions claimed by the applicants anywhere in the reference, and as per discussion above it is believed that the reference provide sufficient disclosure to arrive to the claimed properties. It has been long established by the court that the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re Lemelson*, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*,

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150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. In re Susi, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." In re Gurley, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Once again, the preamble limitation of pending claims 1-5 is considered to be inherently met by the compositions disclosed by the reference and is further not considered to be patentably limiting the claims in view of the statement of the applicants on the record as discussed above.

The applicants further argue that the showings of unexpected results of the blended composition as compared to individual components of the compositions are proper to rebut the prima facie case of obviousness. This argument is not persuasive and legally incorrect. It is immaterial whether the applicants discovered some unexpected improvements over individual components or some other compositions known in the art. The inventors must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. In re Burckel, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979). In the instant case, the prior art already

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discloses the blended composition and the only difference between the compositions exemplified as preferred embodiments of the prior art and the claimed compositions lies in the melt index of the composition, and not in the components. Thus, in order to be effective in rebuttal of the prima facie obviousness, the unexpected results have to be attributed to the differences between the prior art and the claimed invention, i.e., the melt index.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

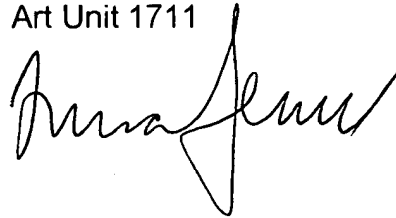
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ISZ

Irina S. Zemel  
Examiner  
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A handwritten signature in black ink, appearing to read 'Irina Zemel', with a stylized flourish at the end.